UNITED STATES PATENT AND TRADEMARK OFFICE

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10/521,848	01/21/2005	Minne Van Der Veen	NL 020670	6183

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER
SCHWARTZ, DARREN B

ART UNIT	PAPER NUMBER
2435	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

Office Action Summary	Application No.	Applicant(s)
	10/521,848	VAN DER VEEN ET AL.
	Examiner	Art Unit
	DARREN SCHWARTZ	2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 14* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-10 and 14* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant canceled claims 11-13 and amended claims 1-10 and 14 are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 November 2008 has been entered.

Response to Arguments

1.   Applicant's arguments filed 26 November 2008 have been fully considered but they are not persuasive.

2.   Applicant argues "the Office cannot hold because of applicant's digital watermark <u>associated with the first data sequence</u>. **In Shuster the first and second checksums are generated from a file corresponding to two different length portions of the file (col. 5, lines 50-64).** Thus the second checksum in Shuster is from a second portion of the file. The second checksum in Shuster is not associated with the first portion of the file from which the first check sum is calculated."

The Examiner disagrees and has bolded key words found in applicant's argument of claim 1. The phrase "associated with" is broadly interpreted. The Examiner has interpreted, but is not necessary limited to, "calculated using." Yet, applicant's arguments have failed to differentiate the claimed invention in view of Shuster. The Examiner notes that Shuster does in fact teach: "As

described above, the first one thousand bytes and the first ten thousand bytes are used for the two

checksums, respectively. For most applications, the use of the entire file or a larger portion of the file

is not necessary and indeed may slow the process; however, there is no reason why the entire file or

any other subset of the file could not be used" (Shuster: col 6, lines 20-25).

3.   Applicant argues "Therefore, the second checksum in Shuster cannot be said to be equivalent

to applicants' digital watermark associated with the first data sequence, because the second

checksum in Shuster is associated with a second portion of the file, which is different from the first

portion."

The Examiner disagrees. Firstly, applicant's claimed invention teaches a "first digital data

sequence" and a "second digital data sequence," yet nowhere does the claimed invention state how

said digital data sequences are distinct or separate.

Secondly, applicant's argue "...the second checksum in Shuster is associated with a second

portion of the file, which is different from the first portion," The applicant is reminded that although the

claims are interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thirdly, Shuster teaches: "As described above, the first one thousand bytes and the first ten

thousand bytes are used for the two checksums, respectively. For most applications, the use of the

entire file or a larger portion of the file is not necessary and indeed may slow the process; however,

there is no reason why the entire file or any other subset of the file could not be used" (Shuster: col 6,

lines 20-25).

For at least the following reasons, the Shuster reference is again upheld. However, to further

prosecution, the Examiner has introduced a new ground of rejection below.

Claim Objections

Claims 7 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form

for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s)

in independent form.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the

rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Shuster, (U.S. Pat

6826546 B1), hereinafter referred to as Shuster.

Re claims 1, 4 and 8: Shuster teaches a method for identifying a first digital data sequence, a

system for identifying a first digital data sequence comprising a processor (col 4, lines 39-42), a

method for enabling identification of a first digital data sequence and a system for enabling

identification of a first digital data sequence (col 5, lines 30-35) comprising:

- calculating a first digital fingerprint [generate first checksum] based on at least part of the first

sequence ["initial checksum based upon a small amount of data reduces the burden on the network

and file server"] (Fig 1: elt 116 & 120; col 5, lines 55-58 and lines 61-64),

- comparing the first fingerprint [first checksum] with at least a second fingerprint associated

with at least a second digital data sequence ["compares the first checksum with a library of known

checksum values that are stored in database"] (Fig 1: elt 120, 124 & 128; col 5, lines 65 – col 6, line

1),

- depending on a result of the comparison [Fig 1, elt 128] (col 6, lines 3-7), calculating a digital

watermark associated with the first data sequence and comparing the calculated digital watermark

with a watermark associated with the second digital data sequence ["the second checksum is then

uploaded to the server, and is compared to the library of known checksum values for a match in the

database"] (Fig 1: elt 136, 140, 144 & 148; col 6, lines 8 - 12) in order to establish an identity of the

first digital data sequence (Fig 1: elt 148 & 152; col 6, lines 12-13 and lines 15-18).

Re claims 2, 5 and 9: Shuster further teaches calculating the digital watermark [second

checksum] associated with the first data sequence, is dependent on information contained in the first

fingerprint (col 6, lines 15-17 and lines 20-24).

Re claims 3, 6 and 10: Shuster further teaches calculating the digital watermark [second

checksum] associated with the first data sequence is dependent on information [Fig 1, elt 128]

resulting from the comparison between the first fingerprint [first checksum] and the second fingerprint

["a library of known checksum values that are stored in database"] (col 5, line 64 – col 6, line 8).

Shuster teaches the calculation between the second checksums is performed only when the first

checksums are validated.

Re claims 7 and 14: Shuster teaches a computer program embedded in a computer readable

medium for controlling a computer to perform a method according to claims 1 and 8 (col 2, lines 45-

53; claim 1: col 8, lines 46-50).

4.   Claims 1, 4 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Brunk et al,

(U.S. Pat Pub 2002/0126872 A1), hereinafter referred to as Brunk.

Re claims 1, 4 and 8: Brunk teaches a method for identifying a first digital data sequence, a

system for identifying a first digital data sequence comprising a processor (¶4; ¶35), a method for

enabling identification of a first digital data sequence and a system for enabling identification of a first

digital data sequence (¶5-¶6) comprising:

calculating a first digital fingerprint based on at least part of the first sequence; comparing the

first fingerprint with at least a second fingerprint associated with at least a second digital data

sequence (¶7; ¶20-¶21),

- depending on a result of the comparison (¶7; ¶49), calculating a digital watermark associated

with the first data sequence and comparing the calculated digital watermark with a watermark

associated with the second digital data sequence (¶8-¶9) in order to establish an identity of the first

digital data sequence (¶36-¶38; ¶52; ¶57; ¶96).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references

applied to the claims above for the convenience of the applicant. Although the specified citations are

representative of the teachings of the art and are applied to specific limitations within the individual

claim, other passages and figures may apply as well. It is respectfully requested from the applicant in

preparing responses to fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the

examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate

the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and

also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

U.S. Pat 5982891 A teaches watermarks relevant to applicant's invention in col 37, line 20 –

col 38, line 40.

U.S. Pat Pub 2002/0028000 A1

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The

examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained

from either Private PAIR or Public PAIR. Status information for unpublished applications is available

through Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-

786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./
Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435